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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,443	11/14/2001	David Botstein	P2730PIC12	2356
35489 7590 12/05/2008 GOODWIN PROCTER LLP 135 COMMONWEALTH DRIVE MENLO PARK, CA 94025				
EXAMINER KEMMERER, ELIZABETH				
ART UNIT		PAPER NUMBER		
1646				
MAIL DATE		DELIVERY MODE		
12/05/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID BOTSTEIN,
AUDREY GODDARD, PAUL J. GODOWSKI,
AUSTIN L. GURNEY, MARGARET ANN ROY
and
WILLIAM I. WOOD

Application No. 09/990,443
Technology Center 1600

Mailed: December 5, 2008

Before PAMELA S. BENNETT, *Review Team Paralegal*
BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on November 12, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is

herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

APPEAL BRIEF, HEADINGS

A review of the file indicates that the Appeal Brief filed April 22, 2008 does not comply with 37 CR § 41.37c) because it does not contain all required heading items. Specifically, 37 CFR § 41.37(c)(1) requires the following heading items in the following order:

- (i) *Real party in interest.*
- (ii) *Related appeals and interferences.*
- (iii) *Status of claims.*
- (iv) *Status of amendments.*
- (v) *Summary of claimed subject matter.*
- (vi) *Grounds of rejection to be reviewed on appeal.*
- (vii) *Argument.*
- (viii) *Claims appendix.*
- (ix) *Evidence appendix.*
- (x) *Related proceedings appendix.*

An in-depth review of the Appeal Brief indicates that the following section is missing from the Appeal Brief filed April 22, 2008 and/or is not complete:

- (ii) *Related appeals and interferences.*

Specifically, the Appeal Brief fails to mention Application Serial No. 09/941,992,¹ which contains an Appeal Brief filed on April 10, 2008. A paper that is in compliance with 37 CFR § 41.37(c) correcting the “Related appeals and interferences” section is required. Submission of an entire new Appeal Brief is not necessary.

INFORMATION DISCLOSURE STATEMENT

Appellants filed an Information Disclosure Statement (IDS) dated May 30, 2002. There is no indication on the record that the Examiner has considered the above IDS. MPEP § 609 requires the Examiner to consider any IDS filed by appellants if timely submitted. A written communication notifying appellants of the Examiner’s consideration of the above IDS is required.

CONCLUSION

Accordingly, it is **ORDERED** that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed April 22, 2008 defective;
- 2) for notification to appellants to file a paper in compliance with 37 CFR § 41.37 which corrects the “Related appeals and interferences” section;
- 3) for consideration of said paper;
- 4) for acknowledgement and consideration of the IDS filed May 30, 2002; and

¹ The present application is a continuation of 09/941,992.

5) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

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